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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,022	09/26/2001	Anthony J. Baerlocher	0112300-484	9873
29159	7590	10/21/2003		
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			EXAMINER NGUYEN, KIM T	
			ART UNIT 3713	PAPER NUMBER
			DATE MAILED: 10/21/2003	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,022

Applicant(s)

BAERLOCHER ET AL.

Examiner

Kim Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9, 11-14, 16, 17, 20, 21, 28-33, 44-46 and 48 is/are allowed.
- 6) ☒ Claim(s) 22, 23, 25-27, 34, 35 and 40-42 is/are rejected.
- 7) ☒ Claim(s) 10, 15, 18, 19, 24, 36-39, 43 and 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Applicant's election in response to the restriction requirement on October 3, 2003 (paper No. 6) is acknowledged. Currently, applicant elects species 1, claims 1-48, without traverse. Claims 1-50 are pending in the application.

Claim Objections

1. Claims 10, 15, 18-19, 22, 24, 27-28, 38, 43, and 47 are objected to because of the following informalities:

- a) In claim 10, line 2, the claimed limitation "a total" should be corrected to "the total".
- b) In claim 15, line 2, the claimed limitation "of plurality of stages" should be corrected to "a plurality of stages".
- c) In claims 18-19, line 2, the claimed limitation "a player" should be corrected to "the player".
- d) In claim 22, line 12; and claim 27, line 9, the claimed limitation "the player" should be corrected to "a player".
- e) In claim 24, line 4, the claimed limitation "the number of picks" should be corrected to "a number of picks".
- f) In claim 28 and claim 43, step (e), the claimed limitation "including" should be corrected to "accumulating" because the number of points must be accumulated from a number of choices before a generation amount could be reached.

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- g) In claim 38, line 2, the claimed limitation “returning to step (a)” should be corrected to “repeating steps (a) to (e)”.
- h) In claim 43, step (h), the claimed limitation “returning to step (c)” should be corrected to “repeating steps (c) to (g)”.
- i) In claim 46, the claimed limitation “the set of picks” should be corrected to “a set of picks”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 27, lines 12-13, the claimed limitation “if the player accumulates the regeneration amount of points” is ambiguous. It is not clear how much the regeneration amount of points be accumulated before the new number of player selections be provided?

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 22-23, 25-27, 34-35, and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slomiany et al (US. patent No. 6,159,098).

a. As per claim 22-23 and 27, Slomiany discloses a gaming device comprising a display, a processor (Fig. 1b); a plurality of choices, a number of points associated with each choice (Fig. 7 and col. 8, lines 3-12), means for selecting a number of choices (Fig. 1b), an accumulated point total (col. 8, lines 55-56), a first award based on the accumulated point total and a second award based on whether the player achieves a goal (col. 7, lines 58-65; col. 9, lines 14-22; and col. 8, lines 31-37). Slomiany does not explicitly disclose a goal which is an amount of points. However, Slomiany discloses establishing a goal ("pig completed" in col. col. 8, lines 31-37; and col. 7, lines 61-65). Further, providing a number of points for each successful choice would have been well known to a person of ordinary skill in the art at the time the invention was made. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to assign a number of points to the successful choice of Slomiany in order to facilitate determining a second award based on the predetermined amount of points obtained.

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b. As per claim 25, consolation award would have been a well known type of award.

Providing a consolation award upon a selection of the choice would have obvious to a person of ordinary skill in the art at the time the invention was made, since choosing a type of award for a choice according to the designer's preference requires only routine skill in the art.

c. As per claim 26, repeating a game as a bonus game would have been well known to a person of ordinary skill in the art at the time the invention was made.

d. As per claim 34-35, Slomiany discloses a method of operating a game comprising the steps of accumulating a player's total points (col. 8, lines 55-56), determining a percentage and assigning a point pool associated with the percentage (col. 7, lines 66-67; and col. 8, lines 11-30), generating a point value (Fig. 1b; and col. 8, lines 15-30). Slomiany does not explicitly disclose enabling the player to select a choice. However, allowing the player to select a choice would have been well known to a person of ordinary skill in the art at the time the invention was made. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow the player to select a choice in order to allow the player directly chooses a choice he wants to pick.

e. As per claim 40-42, refer to discussion in claims 22, 25, and 34 above.

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Allowable Subject Matter

5. Claims 1-9, 11-14, 16-17, 20-21, 28-33, 44-46 and 48 are allowed.
6. Claims 10, 15, 18-19, 43, and 47 would be allowable if rewritten or amended to overcome the objections, set forth in this Office action.
7. Claims 24 and 36-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (703) 308-7915. The examiner can normally be reached on Monday-Thursday from 8:00AM to 5:00PM ET. The central official fax number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

kn
Date: October 18, 2003


KIM NGUYEN
PRIMARY EXAMINER